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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

PAPER NUMBER

1794

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/619,511	Applicant(s) KATOH ET AL.	
	Examiner Patricia L. Nordmeyer	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawn Rejections

1. Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 – 4, 7 – 9, 11 – 14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "wherein the second surface of the base material between the protective material is a material selected from the group" in claim 1 is unclear, which renders the claim vague and indefinite. It is unclear from the claim language if the base material is two different materials as it refers only the second surface.

The phrase "wherein the back surface of the release sheet between the protective material is a material selected from the group" in claim 3 is unclear, which renders the claim vague and indefinite. It is unclear from the claim language if where the back surface is in relation to the rest of the laminate. It is also unclear from the claim language if the release sheet is two different materials as it refers only the second surface.

Claims 2, 4, 7 – 9, 11 – 14 and 16 are also rejected under 35 U.S.C. 112 2nd paragraph due to their dependency on the above rejected claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 – 4, 8, 9, 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ward et al. (USPN 5,384,174).

Ward et al. disclose a laminate sheet (Figures 1 and 3) comprising: a long release sheet (Figure 3, #3); an adhesive layer in continuous direct contact and coextensive with the release surface of the long release sheet (Figure 3, #2); a base material having a first surface and a second surface (Figure 3, #1), the first surface being opposite to the second surface (Figure 3, #1), the first surface being in continuous direct contact and coextensive with the adhesive layer opposite to the long release sheet (Figure 3, #1 and 2), the base material being of a different material than the adhesive layer (Column 3, lines 9 – 23 and lines 34 - 43); and a protective material provided longitudinally on and in continuous direct contact with a generally peripheral portion of the second surface of the base material (Figure 3, #4; Figure 4, #14; Column 6, lines 37 - 50), wherein the peripheral portion corresponds to a portion other than a principally used portion of the adhesive layer (Figure 4, #14), wherein the protective material is provided on both

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sides of the second surface of the base material spaced apart in the widthwise direction thereof (Figure 4, #14), wherein the second surface of the base material between the protective is polyamide (Column 3, line 18) or wherein the back surface of the release sheet between the protective material is polyamide (Column 3, line 18) as in claims 1 and 3. With regards to claims 2 and 4, a central portion of the adhesive layer in the widthwise direction thereof is the principally used portion of the adhesive layer (Column 6, lines 51 - 58). As in claims 8, 9, 13 and 14, the protective material has a band-like shape (Figure 4, #14) and a uniform width (Figure 4, #14), or the protective material has a shape with an edge adjacent to the principally-used portion (Figure 4, #14).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7, 11, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward et al. (USPN 5,384,174) in view of Rogers et al. (USPN 5,376,418).

Ward et al. disclose the claimed laminate sheet except for when the laminate sheet is wound into a roll, the protective material serves as a spacer between the base material and the long release sheet and wherein a thickness of the protective material is between 5 μ m and 100 μ m.

Rogers et al. teach that it is known to place laminate sheets (Figure 1, #12) onto a release material wound into a roll (Figure) for the purpose of protecting an image on the laminate structure (Column 2, lines 15 – 20).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the laminate in a roll in Ward et al. in order to protect an image on the laminate structure as taught by Rogers et al. Therefore, the protective material serves as a spacer between the base material and the long release sheet.

Ward et al., as discussed above, fails to expressly teach that the thickness of the protective material is between 5 and 100 microns. It would have been obvious to one having ordinary skill in the art to provide Ward's laminate to have a 5-100 microns protective material because it is well known and conventional in the adhesive art to provide protective material covering the adhesive to have a thickness of between 5 and 100 microns, based on optimization through routine experimentation, for minimizing cost as the protective material is discarded as waste.

Response to Arguments

8. Applicant's arguments with respect to claims 1 – 4, 7 – 9, 11 – 14 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794